



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/077,173	11/12/98	COMMUNI	D VANNA83.001A

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EXAMINER

MURPHY, J

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

12/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/077,173

Applicant(s)

COMMUNI ET AL.

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-92 is/are pending in the application.
- 4a) Of the above claim(s) 81-83, 85-88 and 90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-80, 84, 89 and 91-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
 2. ☐ received in Application No. (Series Code / Serial Number) _____.
 3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1646.

Claims 70, 73-75, 80 and 84 were amended, and new claims 91-92 were added, in Paper No. 12, 9/30/2000.

Claims 70-80, 84, 89 and 91-92 are under consideration.

The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office Action.

Response to Amendment

The rejection of claim 75 under 35 USC § 112, first paragraph, as lacking written description, has been obviated by Applicant's amendment, and is thus withdrawn.

The rejection of claim 80 under 35 USC § 112, first paragraph, as lacking written description, has been obviated by Applicant's amendment, and is thus withdrawn.

The rejection of claim 70, 80 and 84 under 35 USC § 112, second paragraph, for use of the terms "specifically hybridize", "unique", "included" and "preference", has been obviated by Applicant's amendment, and is thus withdrawn.

The rejection of claim 80 under 35 USC § 102(b) as being anticipated by Parr et al. has been obviated by Applicant's amendment, and is thus withdrawn.

Claim Rejections - 35 USC § 112 first paragraph

Claims 70-79, 84 and 89 stand rejected, amended claim 80, and new claims 91-92 are rejected, under 35 USC § 112, first paragraph, for reasons of record set forth in Paper No. 10, 4/5/2000. Specifically, the specification, while being enabling for a substantially purified polypeptide comprising an amino acid sequence set forth in SEQ ID NO: 2, and encoded by a polynucleotide as set forth in SEQ ID NO: 1, does not reasonably provide enablement for an isolated receptor variant having at least 60% amino acid sequence homology with SEQ ID NO: 2, or encoded by a polynucleotide having more than 60% sequence homology to the polynucleotide as set forth in SEQ ID NO: 1. Applicant argues that it would require little experimentation by one of skill in the art to produce and test. As set forth in Paper No. 10, 4/5/2000, there is no guidance provided in the specification as to how one of ordinary skill in the art would generate either a nucleic acid sequence encoding an a receptor having a preference for pyrimidine nucleotides over purine nucleotides, or a receptor polypeptide that has a preference for pyrimidine nucleotides over purine nucleotides, other than those exemplified in the specification.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Advisory Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
November 29, 2000


PREMA MERTZ
PRIMARY EXAMINER